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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/615,832

07/10/2003

Yoshifumi Tanimoto

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08/29/2008

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP  
1250 CONNECTICUT AVENUE, NW  
SUITE 700  
WASHINGTON, DC 20036

EXAMINER

MACILWINEN, JOHN MOORE JAIN

ART UNIT

PAPER NUMBER

2142

MAIL DATE

DELIVERY MODE

08/29/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/615,832 | <b>Applicant(s)</b><br>TANIMOTO, YOSHIFUMI |  |
|                              | <b>Examiner</b><br>John M. MacIwinen | <b>Art Unit</b><br>2142                    |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 11-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 11-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 6/10/2008 have been fully considered.
2. Applicant begins by arguing that claim 11, as amended, is not taught by Chang. Specifically Applicant asserts that Chang does not teach "not transmitting the new mail notification if no attachment is present in the received E-mail." The Examiner agrees that Chang does not teach all of claim 11, as amended, and thus the rejection in view of Chang is withdrawn. However, after further consideration, a new grounds of rejection, made further in view of O'Neal and Eguchi has been made; said rejection is discussed further in the rejections below.
3. Applicant next argues, regarding claim 1, that "the Examiner has failed to establish that a consumer in the Chang reference would designate a new mail notification of a reception confirmation mail of electronic mail transmitted previously as a low priority confirmation message." Chang does show users customizing the types of messages pushed to them (col. 5 lines 15 - 30; col. 4 lines 30 - 40). Wakasugi shows where reception confirmation of a previous message is optional (col. 10 lines 4 -19). It is obvious to try reception confirmation messages being a low priority as it is obvious to try a choice from among a finite number of identified and predictable solutions, which in this case correspond to priority levels.
4. Applicant next argues that Wakasugi teaches away, arguing that Wakasugi "clearly discloses that the reception of confirmation E-mail is a high priority since a mail notification regarding reception of delivery confirmation E-mail is sent to a notification

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address.” Applicant cites Fig. 10 for support. However, Fig. 10 of Wakasugi does not disclose “high priority messages” or mention them in any way. Furthermore, col. 10 lines 4 – 19 specifically teaches that such notifications are optional. Applicant’s argument’s thus are not persuasive.

5. Finally, regarding claim 1, Applicant’s arguments are moot in view of the new grounds of rejection discussed below, said new grounds of rejection being necessitated by Applicant’s amendment.

6. Applicant next argues claim 5. Specifically, Applicant argues that Boyle “fails to disclose or fairly suggest registering whether or not to carry out the new mail notification to **each** of a plurality of electronic mail addresses”. However, Boyle in col. 11 line 59 – col. 12 line 10 shows said options. Additionally, col. 14 lines 40 - 50, for example shows a user having their own mailbox, col. 9 lines 5 – 15 shows separate message queues per browser, all which correspond to multiple support for multiple user accounts and thus multiple addresses. Furthermore, claim 5 was rejected under 35 USC 103, Chang in view of Wakasugi and Boyle. Chang shows each customer having their own preferences (Abstract, col. 5 lines 20 - 30) and thus Chang in view of Wakasugi and Boyle meet the limitation “to each of a plurality of electronic mail address” through each customer having their own preferences for their own corresponding address.

7. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

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USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### ***Specification***

8. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter for the reasons given below in the 35 USC 112 written description rejection. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o).

### ***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 1, 5, 11 and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, claims 1 and 5 now recite

"determines not to transmit the new mail notification by the push method protocol when the received electronic mail is a reception confirmation mail of electronic mail transmitted previously".

No support is provided in Applicant's specification for this negative limitation (that is, *not transmitting* the new mail notification . . .). The previously presented claim language has specified

"determines not to transmit **the electronic mail of the** new mail notification . . ." (emphasis

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added)

However, Applicant has removed the “the electronic mail of” language, thus changing the scope of the claim language. The current claim language, noted above, is not supported by Applicant’s disclosure.

Regarding claim 11, said claim now recites

"determines not to transmit the new mail notification by the push method protocol when the received electronic mail is an electronic mail not attached with an attached file".

Fig. 10 of Applicant’s disclosure shows where if the e-mail includes an attached file of a specific type, a new mail notification is transmitted. Fig. 10 also shows the if the received e-mail does not have the attached file of the prescribed type, the new mail notification step is skipped in the flow chart. However, Fig. 10 does not support the negative limitation of "not transmitting" as Fig. 10 only shows that no notice is sent at a particular step, not that no notice is sent at all. Applicant's specification, in paragraphs 61 – 64 further discusses Fig. 10. However, though said paragraphs provide ample support for when a new mail notification is transmitted, said paragraphs provide no support for specifically **not** transmitting the notification.

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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12. Claims 1 – 4, 6 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al. (US 6,292,825 B1), hereafter Chang, in view of Wakasugi et al. (US 6,823,367 B1), hereafter Wakasugi.

13. Regarding claim 1, Chang shows a mailbox which stores received electronic mail by corresponding each of the electronic mail and an electronic mail address of a destination; means for transmitting electronic mail of a new mail notification to the electronic mail address of the destination of a received electronic mail by a push method protocol (Abstract, col. 4 lines 32 - 43, Fig. 2); and

means for distributing the electronic mail by a pull method protocol in accordance with a distribution request from the electronic mail address of the destination of the electronic mail stored in the mailbox (Figs. 2, 4 and 5),

wherein the means for transmitting determines whether or not to transmit the electronic mail of the new notification by the push method protocol in accordance with a type of received electronic mail (col. 4 lines 32 - 43, col. 5 lines 22 - 26, col. 6 lines 44 - 51)

and where users can customize the messages pushed to them (col. 5 lines 15 – 30, col. 4 lines 30 – 40).

Chang does not explicitly show where a confirmation of an electronic mail transmitted previously is a type of message optionally pushed to users.

Wakasugi shows where reception confirmation of previous messages is optional (col. 10 line 4 – 19).

It would have been obvious to one of ordinary skill in the art at the time of the

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invention to modify the disclosure of Chang with that of Wakasugi in order to ensure that the status important messages could be verified through the use of email confirmation messages, and to ensure that users can configure their notification options to fit their preferences.

It would have been obvious to try both options regarding a confirmation of an electronic mail transmitted previously is a type of message optionally pushed to users, as it is obvious to try choosing from a finite number of solutions/options (in this case, either transmitting or not transmitting the reception confirmation mail).

Chang in view of Wakasugi thus show all of claim 1.

14. Regarding claims 2 and 6, Chang in view of Wakasugi further disclose a mail server and mail receiving terminal devices according to claims 1, 4 and 11, including where the push method protocol is SMTP (Wakasugi, col. 5 lines 30 – 35, col. 6 lines 58 – 65, col. 17 lines 1 – 10).

15. Regarding claim 3, Chang in view of Wakasugi further disclose wherein the pull method is POP (col. 5 lines 35 – 38, col. 6 lines 58 – 65, col. 17 lines 1 – 10).

16. Regarding claim 4, Chang in view of Wakasugi disclose where when the electronic mail address of the destination of the received electronic mail is an electronic mail address designated in advance, the means for transmitting transmits electronic mail of a new mail notification by the push method protocol (Chang col. 4 line 30 – col. 5 line 30).



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17. Regarding claim 15, Chang in view Wakasugi disclose the means for transmitting notifies an amount of data of the received electronic mail by new mail notification (Chang, col. 4 lines 60 - 67).

18. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chang in view of Wakasugi as applied to claim 1 above, and further in view of Boyle et al. (6,119,167), hereafter Boyle.

19. Regarding claim 5, Chang in view of Wakasugi further show a mail server comprising a mailbox which stores received electronic mail by corresponding each of the electronic mail and an electronic mail address of a destination; means for transmitting electronic mail of a new mail notification to the electronic mail address of the destination of a received electronic mail by a push method protocol (Abstract, col. 4 lines 32 - 43, Fig. 2); and

means for distributing the electronic mail by a pull method protocol in accordance with a distribution request from the electronic mail address of the destination of the electronic mail stored in the mailbox (Figs. 2, 4 and 5),

wherein the means for transmitting determines whether or not to transmit the electronic mail of the new notification by the push method protocol in accordance with a type of received electronic mail (col. 4 lines 32 - 43, col. 5 lines 22 - 26, col. 6 lines 44 - 51).

wherein the means for transmitting determines not to transmit the new mail notification by the push method protocol when the received electronic mail is a reception confirmation mail of electronic mail transmitted previously (Chang, col. 5 lines 15 - 30,

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col. 4 lines 30 – 40; Wakasugi, col. 10 lines 4 – 19)

where when the electronic mail address of the destination of the received electronic mail is an electronic mail address designated in advance, the means for transmitting transmits electronic mail of a new mail notification by the push method protocol (Chang col. 4 line 30 – col. 5 line 30).

Chang in view of Wakasugi further show where each user can have their own preferences, thus establishing options for each user's address, and thus options for each of a plurality of electronic mail addresses (Chang, Abstract, col. 5 lines 20 – 30, show options for 'consumers' ).

Chang in view of Wakasugi do not explicitly show where options include means for registering whether or not to carry out the new mail notifications and wherein the means for transmitting determines whether or not to carry out a new mail notification in accordance with registered contents of the means for registering.

Boyle shows means for registering whether or not to carry out the new mail notification to each of a plurality of electronic mail addresses; wherein the means for transmitting determines whether or not to carry out a new mail notification in accordance with registered contents of the means for registering (col. 11 line 59 – col. 12 line 10).

It would have been obvious to one of ordinary skill in the art to modify the disclosure of Chang in view of Wakasugi with that of Boyle in order to support additional email push and pull options and configurations, making the resulting invention more customizable to user's needs.

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20. Claims 11, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang, in view of Eguchi (2002/0054363 A1) further in view of O'Neal (US 6,711,154).

21. Regarding claim 11, Chang discloses a mailbox which stored received electronic mail by corresponding each electronic mail and an electronic mail address of a destination (Abstract, Figs. 2, 4 and 5, col. 4 lines 32 – 43);

means for transmitting new mail notifications to the electronic mail address of the destination of a received electronic mail by a push method protocol; and (Abstract, Fig. 2, col. 4 lines 32 – 43)

means for distributing the electronic mail by a pull method protocol in accordance with a distribution request from the electronic mail address of the destination electronic mail stored in the mailbox (Figs. 2, 4 and 5)

wherein the means for transmitting the new mail notification by the push method protocol when the type of the received electronic mail is an electronic mail of a type designated in advance (col.4 lines 30 – 67)

Chang does not explicitly show determining not to transmit the new mail notification when the received electronic mail is an electronic mail not attached with an attached file.

Eguchi shows where electronic mail servers and system support faxed documents by converting the faxed document into an email with an attachment (Abstract, [18]).

It would have been obvious to one of ordinary skill in the art at the time of the

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invention to modify the disclosure of Chang with that of Eguchi in order to support the delivery of faxes in Chang's email system as well as the notification of delivery of said faxes in order to keep users better informed above the documents that have been sent to them electronically; faxes and email both being electronic message transmissions.

Chang in view of Eguchi thus support received email faxes, where faxes are appended to email as attachments, but do not explicitly show determining not to transmit the new mail notification when the received electronic mail is an electronic mail not attached with an attached file.

O'Neal shows where notifications are only sent when you receive a fax (col. 11 lines 23 - 45).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the disclosure of Chang with that of O'Neal in order to ensure that users are notified at the appropriate and desired times.

Chang in view of Eguchi and O'Neal thus show a electronic message notification system where when the only time a user receives a notification is when said user is sent a fax; which in said system is translated into an email with an attachment. Chang in view of Eguchi thus show wherein the means for transmitting determines not to transmit the new mail notification by the push method protocol when the received electronic mail is an electronic mail not attached with an attached file.

22. Regarding claim 12, Chang in view of Eguchi and O'Neal further show where pushing the attachment when the received electronic mail is an electronic mail which a

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file of a prescribed type is attached as an attached file (O'Neal, col. 11 lines 23 - 45 and Chang, col.4 lines 30 – 67).

23. Regarding claim 13, Chang in view of Eguchi and O'Neal further show where the file of the prescribed type is an image file or a file in a format converted into character data from the image file (Eguchi, Abstract, Fig. 1).

24. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chang in view of Eguchi and O'Neal as applied to claim 11 above, and further in view of Wakasugi.

Chang in view of Eguchi and O'Neal show claim 11.

Chang in view of Eguchi and O'Neal do not explicitly show where the push method is SMTP.

Wakasugi shows where the push method protocol is SMTP (Wakasugi, col. 5 lines 30 – 35, col. 6 lines 58 – 65, col. 17 lines 1 – 10).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the disclosure of Chang in view of Eguchi and O'Neal with that of Wakasugi in order to utilize an industry standard mail protocol.

### ***Conclusion***

25. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. MacIlwinen whose telephone number is (571) 272-9686. The examiner can normally be reached on M-F 7:30AM - 5:00PM EST; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

John MacIlwinen

(571) 272 – 9686

/Andrew Caldwell/  
Supervisory Patent Examiner, Art Unit 2142